

REMARKS

This Amendment and Response is submitted in reply to the Final Office Action dated April 9, 2007, in which the Examiner:

rejected claim 1 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0180570 to Cercone et al.;

rejected claims 1, 3 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,408,112 to Kazlauskas;

rejected claims 4, 5, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas; and

indicated claim 13 would be allowable if rewritten in independent form.

Applicants respectfully traverse the rejections below. Claims 2, 6, 7, 11 and 12 were previously withdrawn in response to a Restriction Requirement; claims 1, 3-5 and 8-10 are currently pending. The current amendment cancels claims 1 and amends claims 3 and 8, leaving claims 3-5, 8-10 and 13 pending upon entrance of the current amendment. Claims 3 and 8, directed to various welded portion constitutions, are independent claims.

Applicants submit that independent claims 1, 3 and 8, and their respective dependent claims, were patentably distinct from the prior art of record in their previously-presented form. However, to further prosecution, Applicants have cancelled claim 1, and amended claims 3 and 8 to further distinguish them from the prior art of record. Applicants believe that the amendments to claims 3 and 8 do not require substantial additional searching and examination, and request that these amendments be entered despite the Final status of the outstanding Office Action.

In the event that the Examiner determines not to enter the claim 3 and 8 amendments, Applicants wish to specifically note that the following arguments are equally applicable to the previously presented claims 3 and 8 (and their respective dependent claims). Accordingly, Applicants respectfully request that the Examiner consider the following arguments, in view of the previously presented claims 3 and 8, if the amendments to claims 3 and 8 are not entered.

Claim 3 was rejected under 35 U.S.C. § 102(b) as anticipated by Kazlauskas. An anticipation rejection under 35 U.S.C. § 102 is improper unless a single prior art reference shows or discloses each and every claim recitation. Applicants' claim 3 recites, in part, a constitution for a butt-welded portion between tubular members in which a tubular strip is arranged inside of the abutting portion, wherein said contact, inclined and stepped portions are formed by a bend in said end portion.

Kazlauskas does not show or disclose each and every recitation of Applicants' claim 3. For instance, Kazlauskas does not show or disclose an abutting portion [of two tubular members], inside of which a tubular strip is arranged. Instead, inner insert ring 20 is located *between* Kazlauskas' pipes 10 and 12. (See, e.g., Kazlauskas' Figure 3; col. 2, lines 38-43.) Thus, pipes 10 and 12 both abut the insert ring 20 and do not abut each other. Therefore, there is no abutting portion of pipes 10 and 12, unlike the welded portion constitution of Applicants' claim 3.

Additionally, Kazlauskas does not show or disclose contact, inclined and stepped portions are formed by a bend in an end portion of either pipe 10, 12. The Examiner asserts, however, that "the prior art structure can be formed by a bending operation, even if the prior art does not explicitly state how or offers a different method of forming a bent shape." (Final Office Action, p. 4.) Applicants respectfully disagree. First, Applicants' claim recitation, "formed by a bend in said end portion," does not necessarily require that a bend be formed by a "bending operation," as the Examiner appears to imply. Second, there is no "bent shape" in an end portion of either of Kazlauskas' pipes 10, 12, whether formed by a "bending operation" or otherwise. Instead, there is a chamfered section 14. Chamfered section 14 is not a bent shape, regardless of how it was formed.

Thus, Kazlauskas does not show or disclose each and every recitation of Applicants' claim 3. Accordingly, Applicants respectfully submit that the rejection of claim 3 under 35 U.S.C. § 102(b) as anticipated by Kazlauskas is improper for at least this reason, and should be withdrawn.

Claim 8 was rejected under 35 U.S.C. § 102(b) as anticipated by Kazlauskas. Applicants' claim 8 recites, in part, a constitution for a fillet-welded portion between a sheet material and a base material, wherein said contact, inclined and stepped portions are formed by a bend in said end portion.

Kazlauskas does not show or disclose each and every recitation of Applicants' claim 8. For instance, Kazlauskas does not show or disclose a constitution for a fillet-welded portion between a sheet material and a base material. Instead, Kazlauskas discloses an in-line weld of two pipes 10, 12, neither one of which pipes is properly considered a sheet material.

Additionally, Kazlauskas does not show or disclose contact, inclined and stepped portions are formed by a bend in an end portion of either pipe 10, 12, for at least the same reasons discussed in connection with the similar recitation of Applicants' claim 3.

Thus, Kazlauskas does not show or disclose each and every recitation of Applicants' claim 8. Accordingly, Applicants respectfully submit that the rejection of claim 8 under 35 U.S.C. § 102(b) as anticipated by Kazlauskas is improper for at least this reason, and should be withdrawn.

Claims 4, 5, 9 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas. A rejection under 35 U.S.C. § 103 is improper unless the Examiner establishes a prima facie case of obviousness. A prima facie case of obviousness is not established unless the prior art references, alone or in combination, teach or suggest each and every claim recitation.

Claims 4, 5, 9 and 10 each depend directly from either independent claim 3 or 8, and include additional recitations thereto. Claims 3 and 8 both recite an inclined (as well as a contact and a stepped) portion formed by a bend in an end portion of at least one of the weld members.

Kazlauskas does not teach or suggest each and every claim 3 or 8 recitation. For example, Kazlauskas does not teach or suggest an inclined portion formed by a bend in an end portion of one of the weld members. Instead, Kazlauskas teaches chamfering, or cutting, the free ends of pipes 10 and 12. Additionally, Kazlauskas does not teach or suggest an abutting

portion of two tubular members, as recites by claim 3, or the sheet material of claim 8.

Thus, Kazlauskas does not support a prima facie case of obviousness for Applicants' claims 3 or 8. Accordingly, Applicants respectfully submit that the rejection of dependent claims 4, 5, 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Kazlauskas is improper for at least this reason, and should be withdrawn.

Applicants respectfully submit that nothing in the current Amendment constitutes new matter. Amendments to claims 3 and 8 are supported by at least paragraphs [0055] and [0061] of the Specification, and Figures 1 and 6(b).

Having traversed each and every rejection, Applicants respectfully request that the rejections of claims 3-5 and 8-10 be withdrawn, and claims 3-5, 8-10 and 13 be passed to issue.

Applicants believe that no fees are due in connection with this Amendment and Response. If any fees are deemed necessary, authorization is hereby granted to charge any such fees to Deposit Account No. 13-0235.

Respectfully submitted,

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